

REMARKS**Interview request**

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative at (858) 720-5133.

Status of the Claims*Pending claims*

Claims 42 to 55, 88 to 96, 101, 103, 106 to 107, 110 to 112 and 115 to 138 are pending.

Claims canceled in the instant amendment

Claims 101, 103, 106, 107, 117 to 121 and 136 to 138 are canceled, without prejudice or disclaimer. Thus, after entry of these amendments, claims 42 to 55, 88 to 96, 110 to 112, 115, 116, 122 to 135 are pending and under consideration.

Response to the Restriction Requirement

The instant application was restricted to eight (VIII) inventions under 35 U.S.C. §121. Applicants elected Group IV, claims 42-55 and 88-92, drawn to a method of mutagenesis.

Outstanding Rejections

The rejection of claims 42 to 55, 88 to 96, 101, 103, 106, 107, 110 to 112 and 115 to 133, is maintained, and claims 134 to 136 are newly rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement. The rejection of claims 88, 89, 93, 95, 96, 101, 103, 106, 107, 110, 112, 115, 117 to 119 and 124 to 133, is maintained and claims 134 to 138 are newly rejected under 35 U.S.C. §102(b) as allegedly anticipated by Lam, et al., U.S. Patent No. 6,074, 867, issued June 13, 2000, and filed October 15, 1997.

Applicants respectfully traverse all outstanding objections to the specification and rejections of the claims.

Support for the claim amendments and Priority

The specification sets forth an extensive description of the invention in the amended claims. For example, support for claims directed to targeting endonuclease substrates (as small molecules) with polypeptides of the invention, and modifying those substrates, can be found, inter alia, in paragraphs [0027], [0051], [0057] and [0211] of the publication 20020120118; and the paragraph spanning columns 6 to 7, of the priority document U.S. patent no. 5,789,228. Support for claims directed to nucleic acids that can be used to practice the methods of the invention, wherein those nucleic acids can have various sequence identities (e.g., 95%, 97%) to the exemplary sequences of the invention, can be found, inter alia, in the priority document U.S. patent no. 5,789,228, column 5, lines 1 to 16; column 8, lines 24 to 33, and lines 48 to 50; column 9, lines 31 to 38 (see also, paragraphs [0170] and [0171] of the publication 20020120118).

Support for claims directed to nucleic acids that can be used to practice the methods of the invention, wherein those nucleic acids can have various lengths (e.g., 50 bases) to sequences of the invention, can be found, inter alia, in the priority document U.S. patent no. 5,789,228, column 8, lines 39 to 42, and lines 51 to 54; column 9, lines 38 to 41 (see also, paragraphs [0170] and [0171] of the publication 20020120118).

Support for claims directed to nucleic acids that can be used to practice the methods of the invention, wherein those nucleic acids can hybridize under stringent conditions to exemplary sequences of the invention, can be found, inter alia, in the priority document U.S. patent no. 5,789,228, column 4, lines 37 to 67 (see also, paragraphs [0053], [0054] and [159] to [165] of the publication 20020120118).

Support for claims directed to nucleic acids that can be used to practice the methods of the invention, wherein those nucleic acids encode polypeptides having activity comprising hydrolysis of the beta 1,4 glycosidic bonds, can be found, inter alia, in the priority document U.S. patent no. 5,789,228, column 7, lines 23 to 26; and, paragraph [0212] of the publication 20020120118.

The Patent Office acknowledged that claims 42, 94, 111, 120 to 123 properly claimed benefit of priority to the parent application, U.S. patent application serial no. (USSN) 08/651,572, filed May 22, 1996, now U.S. Patent No. (USPN) 5,789,228.

Issues under 35 U.S.C. §112, first paragraph, enablement

The rejection of claims 42 to 55, 88 to 96, 101, 103, 106, 107, 110 to 112 and 115 to 133, is maintained, and claims 134 to 136 are newly rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement.

The Patent Office has issues with whether the disclosure enables the full scope of the claimed invention. While Applicants respectfully traverse, to expedite prosecution of this application, the claims have been amended to address these issues; e.g., the term “small molecule(s)” has been deleted, and the scope of the genus of nucleic acids used in the claimed methods after entry of the instant amendment will be only 95% sequence identity to the exemplary sequences, or limited to nucleic acids that hybridize only under stringent conditions.

Accordingly, Applicants respectfully submit that the pending claims meet the enablement requirements under 35 U.S.C. §112, first paragraph. In light of the above remarks, Applicants respectfully submit that amended claims are fully enabled by and described in the specification to overcome the rejection based upon 35 U.S.C. §112, first paragraph.

Issues under 35 U.S.C. §102

The rejection of claims 88, 89, 93, 95, 96, 101, 103, 106, 107, 110, 112, 115, 117 to 119 and 124 to 133, is maintained and claims 134 to 138 are newly rejected under 35 U.S.C. §102(b) as allegedly anticipated by Lam, et al., U.S. Patent No. 6,074, 867, issued June 13, 2000, and filed October 15, 1997.

While Applicants respectfully traverse, to expedite prosecution of this application, the claims have been amended such that they are unambiguously supported by the priority document U.S. patent application serial no. (USSN) 08/651,572, filed May 22, 1996, now U.S. Patent No. (USPN) 5,789,228, as discussed in detail above. Because the claims (as amended) are sufficiently

described and enabled by the priority document USPN 5,789,228, the rejection of these claims under 35 U.S.C. §102(b) can be properly withdrawn.

Applicants also note that the cited Lam et al., '867 patent is a divisional application of the instant (CIP) application's priority document, i.e., the cited '867 patent is a divisional of (having the same specification as) the parent application USSN 08/651,572.

CONCLUSION

In view of the foregoing amendment and remarks, it is believed that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first paragraphs, and 35 U.S.C. §102. Applicants believe all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants believe that no additional fees are necessitated by the present response and amendment. However, in the event any such fees are due, the Commissioner is hereby authorized to charge any such fees to Deposit Account No. 03-1952 referencing attorney docket no. 564462000520. Please credit any overpayment to this account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at (858) 720-5133.

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Respectfully submitted,

By 

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